

No. 22,059

United States Court of Appeals
For the Ninth Circuit

REIN J. GROEN and WILLIAM A. RICE,
Appellants,

vs.

LUSTIG FOOD CORPORATION, et al.,
Appellees.

BRIEF FOR APPELLEE
GENERAL FOODS CORPORATION

NAYLOR & NEAL,
1650 Russ Building,
San Francisco, California 94104,
Attorneys for Appellee
General Foods Corporation.

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**BRIEF FOR APPELLEE
GENERAL FOODS CORPORATION**

This is an appeal from an Order Granting Motion for Summary Judgment (R. 36) and holding that the letters patent in suit is invalid for failure of the single claim thereof to meet the conditions for patentability prescribed in 35 U.S.C. §102 and §103.

The action was commenced by the filing of a Complaint (R. 1 et seq.) on February 10, 1964 by Appellants, Groen and Rice, as co-plaintiffs, against Lustig Food Corporation and a host of others, including Appellee, General Foods Corporation, charging infringement of Letters Patent No. 2,950,203, granted to Appellants on August 23, 1960 for Process of Quick-Freezing Raw Onions. Though not a necessary part of the record herein, it should be noted that, effective June 1, 1966, Appellants filed a Dismissal without Prejudice as to all defendants save and except Appellee, General Foods Corporation.

The Complaint, after reciting the grant of the letters patent in suit, charged that the defendants for a long time have been and still are infringing the letters patent by making, selling or using devises (sic "devices") and methods embodying the patented invention, and will continue to do so unless enjoined by the Court (Par. III); alleged written notice of infringement prior to the institution of this action (Par. IV), and prayed a preliminary and final injunction against further infringement, an accounting of profits and damages and costs.

The Answer (R. 7 et seq.) of Appellee, General Foods Corporation, joined issue denying due and legal issuance of the letters patent (Par. II); denied infringement (Par. III); denied receipt of notice of alleged infringement (Par. IV) and pleaded further and affirmative defenses bearing on validity (Pars. VI-VIII) and including the failure of Appellants to meet the conditions for patentability prescribed in 35 U.S.C. §102 and §103 (Par. IX).

On December 23, 1964 the depositions of Appellants, Groen and Rice, were taken on behalf of Appellee, General Foods Corporation, and transcripts thereof were transmitted to this Court as a part of the record on appeal.

Appellants propounded certain interrogatories (R. 53 et seq.) to Appellee, General Foods, on April 23, 1965, and answers (R. 59) thereto were filed June 1, 1965, with a supplemental answer to Interrogatory No. 2 (R. 71) filed on July 28, 1966.

On October 21, 1966 Appellee, General Foods Corporation, filed a Motion for Summary Judgment (R. 13 et

seq.) on the grounds of invalidity because of 35 U.S.C. §103 (obviousness), because of 35 U.S.C. §112 (indefiniteness and failure to distinctly claim) and non-infringement. The Motion was based upon the records and papers on file, the depositions of the Appellants and Motion Exhibits A (a breakdown analysis of the single claim of the patent), B (a certified file history of Letters Patent 2,950,203, the patent in suit) and C (a book of the prior art cited by the Patent Office during prosecution of the letters patent in suit).

Appellants filed an Affidavit in Opposition to Motion for Summary Judgment (R. 31) by its counsel, Charles A. Zeller, dealing with only one factual aspect relating to the issue of infringement (see the last paragraph thereof) and this was traversed by an affidavit (R. 34) of Jas. M. Naylor on behalf of Appellee, General Foods Corporation.

On December 30, 1966 the District Court made and entered its Order Granting Motion for Summary Judgment (R. 36). Notice of this appeal followed (R. 46).

JURISDICTION

This suit arose under the Patent Laws of the United States (35 U.S.C. §281) and was brought pursuant to 28 U.S.C. §1400(b). Jurisdiction to review the Order of the District Court is conferred by 28 U.S.C. §1291. The Order appealed from had the effect of dismissal of the Complaint and was, therefore, a final judgment within the provisions of Rule 54(b) F.R.C.P. and the rules of this Court.

STATEMENT OF THE CASE

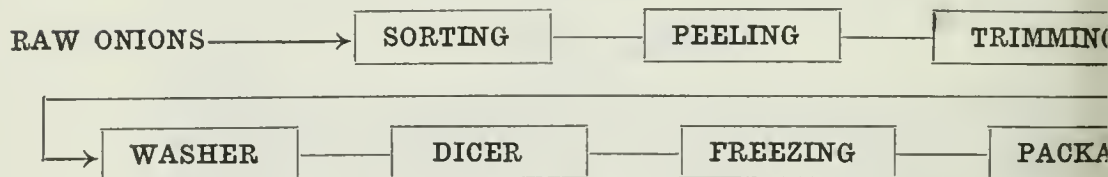
The Groen et al. patent in suit (R. 5) was entitled "Process of Quick-Freezing Raw Onions". Among the statement of objects the following appears:

"Heretofore it has been considered impossible to quick freeze raw onions properly because onions have a high moisture content and do not withstand a blanching step as they become unsuitable for freezing operations because of tissue breakdown." (Column 1, lines 19-23)

Further:

"We have discovered that by dividing the raw onions in suitable pieces such as diced onions, onion rings, or utilizing whole raw onions of a size comparable to onions commonly employed as stewing onions, *the raw onions can be quick frozen satisfactorily without a blanching step*, contrary to the belief in industry." (Column 1, lines 24-29; emphasis supplied)

The flow sheet or drawing forming a part of the application shed further light on the subject matter and it is here reproduced for convenient reference.



The process was further characterized by this statement:

"Throughout the entire process the temperature of the raw onions is maintained at ambient atmospheric temperatures or lower so that no undesirable effects of heating are present in the flesh of the onions. By

ambient atmospheric temperatures we mean temperatures which would affect the onion or onion pieces throughout their flesh.” (Column 2, lines 16-23; emphasis supplied)

The asserted inventive concept was defined in the single claim of the patent which, because of its brevity, is here repeated for ready reference:

“The process of quick-freezing raw onions which comprises sorting the onions, peeling and trimming the onions to remove unedible and undesirable portions thereof, washing the peeled and trimmed onions, cutting the onions into pieces, carrying the onion pieces while unconfined through a freezing zone and effecting an individual freezing operation on each onion piece at least as cold as substantially zero degrees F., and then packaging the onion pieces, the entire process being carried out at substantially ambient atmospheric temperatures.”

A PROPER USAGE OF SUMMARY JUDGMENT

Appellants argue the broad proposition that summary judgments are improper on the issue of validity of a patent and they cite two early District Court decisions to support their contention. The most that can be said for *Baker v. First National Stores*, 64 F.S. 979, 980, 69 USPQ 11, 12 (D.C. Mass., 1946) is that it was an action for patent infringement in which the defense of misuse was raised and presented by motion for summary judgment. In denying the motion for the failure of the de-

defendant to bring its defense within the misuse principle, the District Judge made a general observation that:

“Patent validity is an issue not rightly disposed of by summary judgment.”

The District Court in Massachusetts cited Appellants' second authority, namely, *American Optical Co. v. New Jersey Optical Co.*, 58 F.S. 601, 65 USPQ 114. In that case the complaint sought recovery of royalties under patent licenses and defendant counterclaimed for damages for violation of the Sherman Act. In denying defendant's motion for summary judgment Judge Sweeney (who also decided the *Baker* case, *supra*) made this general observation (65 USPQ 118):

“In the usual infringement case where the validity or scope of the patents is in issue the question cannot be decided without the aid of expert testimony and reference to file wrappers and prior art. Such an issue is not rightly disposed of by summary judgment.”

But these two decisions in the Massachusetts District do not represent the law in this circuit and it is noteworthy that Appellants did not come to grips with the weight of authority here as expressed in:

Park-In Theatres, Inc. v. Perkins, 190 F(2d) 137, 90 USPQ 153 (CA 9);

Rankin v. King, 272 F(2d) 254, 123 USPQ 397 (CA 9);

Walker v. General Motors Corp., et al., 359 F(2d) 474 (CA 9)

affirming decisions granting motions for summary judgment for patent invalidity under proper circumstances,

and

Hughes Blades, Inc. v. Diamond Tool Associates,
300 F(2d) 853, 132 USPQ 305 (CA 9);

Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc.,
263 F(2d) 150, 120 USPQ 72 (CA 9)

neither of which stands for an absolute prohibition against summary judgment disposition of patent cases (as Appellants argue), but instead admonish against the resolution of genuine issues of material fact in the granting of motions for summary judgment.

It is of particular interest that this Court commented on the *Baker* case in its decision in *Rankin* by saying (123 USPQ 400):

“And we will agree that it is ‘usually inappropriate’ to grant summary judgment in the ordinary patent case. *Baker v. First Nat. Stores*, D.Mass. 1946, 64 F.Supp. 979, 980, 69 USPQ 11, 12.”

THE DISTRICT COURT ACTED PROPERLY

An examination of the record clearly shows that the District Court acted properly in the instant case and with due regard for the guidelines laid down by this Court. The trial court had before it the following unchallenged and non-controverted material:

1. A printed copy of the patent in suit, which had been appended to the Complaint as Exhibit A (R. 3).
2. The deposition of Appellant Groen taken on behalf of Appellee, in which there was no cross-examination on behalf of Appellants.

3. The deposition of Appellant Rice taken on behalf of Appellee, in which there was no cross-examination on behalf of Appellants.

4. The deposition exhibits.

5. Motion Exhibit A, a breakdown analysis of the single claim of the patent.

6. Motion Exhibit B, a certified file history of the application.

7. Motion Exhibit C, a book of the prior art cited by the Patent Office during prosecution of the Groen et al. application.

8. Appellants' Interrogatories and Appellee's Answers and Supplemental Answer to Interrogatory No. 2.

The Motion for Summary Judgment was predicated upon these items and the contention that being non-controverted matters of proof they could be looked to for a determination of whether the single claim of the patent validly defined an invention and, if valid, whether the claim was infringed. That the items tendered to the Court were, in fact, non-controverted material admits of no doubt.

Appellants never met the thrust of Appellee's showing relative to validity or infringement, but instead put in an affidavit of its counsel (R. 31) given largely to conclusionary or argumentative statements, without pointing out the existence of any material questions of fact, if any did exist.

Moore, *Federal Practice*, Vol. 6, page 2346, defines Appellants' burden in this way:

“To defeat a movant who has otherwise sustained his burden within the principles enunciated above, the party opposing the motion must present facts in proper form—conclusions of law will not suffice and the opposing party’s facts must be material and of a substantial nature, not fanciful, frivolous, gauzy, nor merely suspicions.” (See footnote annotations.)

As will be noted, the Zeller affidavit (R. 31) did not challenge the authenticity of the facts revealed in items 1-8, noted above, but simply alluded to (a) the absence of a denial of infringement¹ in the motion papers [it was in the Answer, Par. III, where it belonged (R. 7)] and (b) the fact that Appellants’ counsel had seen a package of onions with a White Plains, New York, address, from which he assumed an onion processing plant was maintained there and that Appellee may be using an undisclosed or different process than those employed at Nampa, Idaho, and Walla Walla, Washington. Item (b) was refuted by the Naylor affidavit (R. 34).

It is glaringly apparent that even upon this appeal Appellants do not and cannot point to the existence of a single genuine issue of material fact that was resolved or needed to be resolved in the District Court’s determination of the Motion for Summary Judgment on the basis of the non-disputed facts. This statement appears in Appellants’ Brief, page 5:

“The question of material fact which the court should have recognized appellants were entitled to have tried was: Is the combination of steps the subject of the

¹Appellants overlook the rule that the plaintiff has the burden of proving infringement (*Walker on Patents, Deller’s Edition*, page 2045).

claim of U. S. Letters Patent No. 2,950,203 a patentable invention in the light of the state of the prior art and the laws pertaining to patents?"

This Court has held that something more is required than a mere statement that an issue of fact exists. In *Henderson v. A. C. Spark Plug Division*, 366 F(2d) 389, 151 USPQ 162, 165 (CA 9, 1966), this appears:

"The mere statement that 'an issue exists' does not prevent the granting of a summary judgment below. To abide such a rule would emasculate the statute permitting such judgments."

It is respectfully submitted that when it appears clearly as a matter of law from undisputed facts disclosed by the letters patent, the file history or file wrapper of the patent, and the prior art, both cited and non-cited, that the patent in suit is invalid because of a want of patentable novelty, a motion for summary judgment is properly granted. *Rankin v. King, supra*, is directly in point and controlling.

Under such circumstances a patentee is not "entitled" to a trial on the issue of validity, as Appellants contend, and this would be true even if they had demanded a jury trial. Cf. *Bentley v. Sunset House Distributing Corp.*, 359 F(2d) 140, 149 USPQ 152 (CA 9, 1966).

**THE PRESUMPTION OF VALIDITY OF THE PATENT
IN SUIT HAS BEEN DISSIPATED**

Appellants argue, in effect (Brief pp. 2 and 3), that the presumption of validity, declared at 35 U.S.C. § 282, should have been sufficient to resist the challenge of va-

lidity by the Motion for Summary Judgment. This Court has declared that the presumption of validity of a patent is largely dissipated when it appears that there is one non-cited piece of pertinent prior art.

In *Monroe Auto Equipment Co. v. Superior Industries, Inc.*, 332 F(2d) 473, 141 USPQ 710, 716 (CA 9); cert. den. 379 U.S. 901, 143 USPQ 465 (1964), this Court observed:

“The existence of but one pertinent example of unconsidered prior art is not only sufficient basis to dissipate the presumption of validity (*Pressteel Co. v. Halo Lighting Products, Inc.*, *supra*; *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.*, *supra*), but may render the patent invalid.”

See also:

Henderson v. A. C. Spark Plug Division, *supra*, at page 165 of 151 USPQ.

Further along in this brief the non-cited and pertinent prior art will be pointed out and discussed.

THE FILE HISTORY AND THE CITED PRIOR ART

A study of the file history of the application for the letters patent in suit is quite informative as a preliminary to a consideration of the validity of the single claim which emerged from the prosecution and became the basis of the patent grant. Initially the patentees asserted four claims directed to quick-frozen raw onions or pieces thereof as an invented *product* (Motion Exhibit B, p. 5). The first claim recited:

“As a product, quick-frozen raw onion pieces containing substantially the entire moisture content of

the onions and being free of any effect of heating or blanching.”

Claims 2, 3 and 4 were dependent therefrom and differed in the particulars that the pieces were defined as “diced onions”, “onion rings”, “whole peeled onions”, respectively. The product claims were short-lived, being rejected by the Patent Office Examiner with the observation (Motion Exhibit B, p. 11):

“Claims 1-4, drawn to the product, are rejected as unpatentable over any of the onions, sliced or otherwise, of the prior art whether such onions be frozen or unfrozen. The product of the claims is still only an onion and will differ at best in degree and not in kind. (Maryland Homin v. Dorr, 46 F. 773; In re McKee, 1938 C.D. 425). Accordingly, patentable novelty should be predicated upon the process, and not upon the frozen onion *per se*.”

There followed an argument coupled with affidavits (Motion Exhibit B, at pages 12-30), but the Examiner persisted in his rejection of the product claims (Motion Exhibit B, pages 31-33) and the patentees acceded by cancelling the product claims (Motion Exhibit B, page 35).

Paralleling this abortive attempt to obtain product claims, the patentees initially asserted four process claims (Motion Exhibit B, pages 6-7). These claims were also rejected in the initial Patent Office action (Motion Exhibit B, pages 10-11) reference being had to cited literary references and one patent. In response to that rejection the patentees pointed to a passage in the specification (Motion Exhibit B, page 1, lines 10 to 15 [which also appears in the issued patent, which appears at R. 5,

column 1, lines 23-29]). The patentees took the position in their argument that:

“In fact applicants’ principal discovery was that the blanching step is unnecessary in the quick-freezing of raw onions.” (Motion Exhibit B, page 12)

Subsequently, the patentees called the Examiner’s attention to a reference which they believed to be more pertinent than any cited by the Examiner, namely “Make the Most of Your Food Freezer” by Marie Armstrong Essipoff, published by Rinehart & Company of New York, and copyrighted in 1951 and 1954, Library of Congress card number 54-9436. They acknowledged that the Essipoff book contained a discussion of the freezing of onions at pages 89 through 94 and that they were also mentioned on page 27 and pages 100, 111, and 117, the latter pages particularly mentioning the omission of blanching. With this dissipation of the argument that the applicants’ principal discovery was that the blanching step is unnecessary in the quick-freezing of raw onions, the patentees shifted their grounds and began to talk about a different asserted point of novelty of their process by saying (Motion Exhibit B, page 36):

“The Essipoff disclosure teaches placing the chopped onions in a bag and then placing this bag in a freezer so that the pieces of onions are *not* frozen individually but would be frozen as a group. This is contrary to applicants advantageous teaching of individual freezing of each piece of the onion as duly brought out in the newly presented claim 9.”²

²Of course the Patent Office was wholly unaware that the patentees had made a written description on August 16, 1956, prior to the filing of their application, giving a totally different and contradictory version of what their invention was all about (see Groen deposition pages 16-20 and Defendant General Foods Exhibit 7-B).

Claim 9, which with certain amendments became the single claim of the issued patent, was then presented (Motion Exhibit B, page 35). This claim as presented met with a final rejection (Motion Exhibit B, pages 38-39) and there followed an appeal to the Board of Appeals (Motion Exhibit B, page 40) with a brief in support thereof (Motion Exhibit B, pages 41-46). While the appeal was pending the patentees made certain specific amendments to Claim 9 (Motion Exhibit B, page 47) and the Examiner's resistance was finally worn away and amended Claim 9 was allowed (Motion Exhibit B, page 51).

While the allowance of the lone claim of the patent appears suspect for the obvious failure of the Patent Office to apply the requisite standards of invention (Cf. *Graham v. John Deere & Co.*, 383 U.S. 1, 148 USPQ 459 (1966)), nevertheless the admissions of the patentees as to the state of the art leaves no doubt that the claim is invalid.

THE ADMITTED STATE OF THE ART

The effective prior art date of the patent in suit was March 26, 1956, this being one year prior to the filing of the application for the patent in suit (35 U.S.C. § 102).

Appellants, Groen and Rice, admitted in their depositions and in the file history of their patent to the substantial identity of prior food freezing processes and the subject matter of the patent claim in suit.

The following comparative analysis of the claimed process and the admitted prior art is revealing:

Steps of Patent Claim**Admitted State of the Art**

- | | |
|--|--|
| 1. Sorting the onions | Customary with vegetables
(Groen dep. 24) |
| 2. Peeling and trimming the onions to remove inedible and undesirable portions thereof | Customary with vegetables
(Groen dep. 24) |
| 3. Washing the peeled and trimmed onions | A conventional operation
(Motion Exhibit B, page 2, lines 19-21) |
| 4. Cutting the onions into pieces | Customary with some vegetables
(Groen dep. 24) |
| 5. Carrying the onion pieces | Customary with vegetables |
| (a) while unconfined through a freezing zone | (Customary with peas and beans) |
| (b) effecting an individual freezing operation on each onion piece at least as cold as substantially zero degrees F. | (Customary with some vegetables) (Groen dep. 25; Rice dep. 32 for temperature) |
| 6. Then packaging the onion pieces | A conventional operation
(Motion Exhibit B, page 3, lines 23-26) |

The entire process being carried out at substantially ambient atmospheric temperatures.

In the foregoing analysis we see a concession by the patentees that each step of the process of the claim is admittedly old in the art. The sole point of novelty that can be asserted is that the patentees apply the process to *onions* whereas the prior users applied it to *other vegetables*. But the mere selection or choice of a different item of food to be processed by a process otherwise old can never rise to the dignity of invention. The District Court quite properly placed its reliance on *Brown et al.*

v. Piper, 91 U.S. 37 (1875). The patent there under consideration related to a process for preserving fish and meats, and it was contended that if the process was old it had never been applied to the preservation of fish and meats. That contention was disposed of in this way (p. 41):

“The answer is, that this was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law. The thing was within the circle of what was well known before, and belonged to the public. No one could lawfully appropriate it to himself, and exclude others from using it in any usual way for any purpose to which it may be desired to apply it.

This is fatal to the patent. *Ames v. Howard*, 1 Sumner 487; *Howe v. Abbot*, 2 Story, 194; *Bean v. Smalwood*, id. 411; *Winans v. B. & P. R. R.*, id. 412; *Hotchkiss et al v. Greenwood et al*, 11 How. 248.”

It is an interesting sidelight on the *Brown* case that, although long prior to the modern concept of summary disposition as it is now known under Rule 56, the Supreme Court took judicial notice of the ice cream freezer as prior art to the process under consideration and observed at (p. 43):

“If the cream were taken out of the freezer, and fish put in, there would be, in all substantial respects, the same apparatus, process and result.”

And, further (at p. 44):

“Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument,

and without looking beyond it into the answers and testimony, sua sponte, if the objection were not taken by counsel, well have adjudged in favor of the defendant.”

Applying the admitted state of the art to the claim in suit leads inescapably to a summary holding of invalidity of the claim for failure to meet the conditions for patentability prescribed in 35 U.S.C. §§102 and 103.

THE AMBIENT ATMOSPHERIC TEMPERATURE LIMITATION

The patent claim requires “the entire process being carried out at substantially ambient atmospheric temperatures.” The phrase “ambient atmospheric temperatures” must indicate some recognizable temperature range at which all of the process is carried out; otherwise the claim is invalid for indefiniteness under 35 U.S.C. §112.

The specification of the patent states (R. 5, column 2, lines 16-22) :

“Throughout the entire process, the temperature of the raw onions is maintained at ambient atmospheric temperatures or lower so that no undesirable effects of heating are present in the flesh of the onions. By ambient atmospheric temperatures, we mean temperatures which would affect the onion or onion pieces throughout their flesh.”

In the file history of the patent (Motion Exhibit B, page 42) the patentees’ attorney made the following statement:

“The entire process is carried out at ambient atmospheric temperatures or lower, this step insuring that there is no blanching treatment of the onions or no application of heat thereto which would tend to

deteriorate the structural character of the onion pieces.”

These statements indicate that what the patentees really intend is that the process is carried out *without heating*. The onions are subject only to the normal atmospheric temperatures which they would experience during processing, save and except passage through the freezing zone which would be at variance with ambient atmospheric temperatures. No elevated temperature is applied to the onions which would cause physical effect on them.

Some light is shed on the patentees' own interpretation of the claim in Appellants' Brief (pages 4-5) where this statement appears:

“However, Appellants' position is that the uniqueness of their patent exists in (1) the process of individual (2) quick-freezing of (3) raw onion pieces (4) at substantially ambient temperatures, i.e., *without being subjected to any heat or blanching step*.”
(Emphasis supplied)

Taken literally, this would represent a complete cycle upon the part of the patentees as to what their invention really is, it being recalled that until Mrs. Essipoff's book appeared over the horizon they were contending in the Patent Office that their “principal discovery was that the blanching step is unnecessary in the quick-freezing of raw onions”, from which position they receded, only now to return to it by treating the “ambient atmospheric temperatures” as equal to omission of a blanching or heating step. (Compare the deposition of Groen, pages 28-30, in which it appears that the initial steps of the claimed process were carried on indoors according to the tempera-

ture of the room as they found it, then moving the onion pieces from atmospheric or room temperature into the actual freezing temperature that they were seeking within the freezing apparatus, with some packaging at zero degrees and below and also at room temperature with no observable difference in the end product under those conditions.)

If ambient atmospheric temperature means, as Appellants now say it means, the omission of a blanching or heating step, then Appellants are back where they started and the Essipoff reference is decisive. If, on the other hand, the Appellants try now to give the ambient atmospheric temperature limitation an interpretation which avoids Essipoff, then the concluding phrase of the claim renders the whole claim bad for indefiniteness under 35 U.S.C. §112. In this area the decision of this Court in *Vitamin Technologists, Inc. v. Wisconsin Alumni Foundation*, 146 F(2d) 941, 63 USPQ 262 (CA 9, 1944) is applicable. In that case this Court was concerned with process claims which involved exposing substances to radiation to produce Vitamin D in the substances. The claim attempted to define the time period of radiation in terms of the function which the radiation was to produce. For this reason the Court held the claims invalid, saying (63 USPQ 272):

“Appellant contends, and we agree with it, that the phrase of all the claims of the first and second patents, describing the function of exposure as ‘for a period sufficient to effect antirachitic activation but so limited as to avoid subsequent substantial injury to the antirachitic principle,’ is too vague and uncertain a description of the process to ‘inform the public . . . of the limits of the monopoly asserted.’ ”

THE ISSUE OF INFRINGEMENT

The Motion for Summary Judgment also presented the issue of infringement (R. 14) asserting that the single claim of the patent has not been infringed by Appellee because the process employed by Appellee is neither covered by nor does it respond to the patent claim. The District Court did not reach or rule upon that aspect of the Motion, limiting its ruling to the issue of validity.

Although the issue of infringement is not, strictly speaking, before the Court for determination, nevertheless the issue is still a pending part of the case and the Court has the power and authority to pass judgment upon it, if it so elects. It did so in *Ry-Lock Co. Ltd. v. Sears, Roebuck & Co.*, 227 F(2d) 615, 107 USPQ 292. There, as here, the decision of the trial court was limited to the issue of validity of the patent, but the Court, in reversing a holding of invalidity, proceeded to a determination of the issue of infringement and held the patent infringed in view of the evidence before it. It said (107 USPQ 294):

“The question of infringement remains. The evidence in our judgment so clearly demonstrates infringement that *a finding of no infringement would have been clearly erroneous.*” (Emphasis supplied)

See also: *Illinois Tool Works, Inc. v. Rex L. Brunsing, et al.*, F(2d), 153 USPQ 771 (CA 9, April 28, 1967).

It is the position of Appellee that the uncontroverted evidence before the trial court, and now here, so clearly demonstrated non-infringement of the single claim of the patent as to compel a ruling favorable to Appellee, if that issue is ever reached.

The evidence consisted of the Appellee's sworn answers (R. 59) to Appellants' Interrogatories (R. 53) taken with the Supplemental Answer to Interrogatory No. 2 (R. 71). This material was neither challenged as to substance nor controverted in any material way. This was not surprising as the Appellants testified that, as late as December 23, 1964, they had not investigated General Foods' operations (See: Groen Dep. 12-13; Rice Dep. 11-12). In any event, Appellants did not meet the substance of Appellee's motion showing of non-infringement as they were required to do.

As shown by Appellee's Answers to Interrogatories (R. 59) and the Supplemental Answer to Interrogatory No. 2, the accused process not only differs from the patent claim in its sequential steps of treating the onions, but the whole process of General Foods is carried out at something different than the patentees' "substantially atmospheric temperatures", or the environmental aspect of the patented process. The following, simple analytical chart comparing the processes should prove convincing:

**The Patented Process of
Quick-Freezing Raw Onions**

1. sorting the onions

**General Foods Process
(at Nampa, Idaho)**

1. Raw onions are prepared for peeling by immersion in water at 140°-160° F. for a period of 6-4 minutes, the blancher being normally used for blanching baby lima beans. This immersion softens the outer skin of the raw onion and enables the skin to be removed with the aid of a series of rotating brushes contacting and abrading the skin.

The Patented Process of Quick-Freezing Raw Onions

2. peeling and trimming the onions to remove unedible portions thereof
3. washing the peeled and trimmed onions
4. cutting the onions into pieces
5. carrying the onion pieces
 - (a) while unconfined through a freezing zone and
 - (b) effecting an individual freezing operation on each onion piece at least as cold as substantially zero degrees F., and
6. then packaging the onion pieces

the entire process being carried out at substantially ambient atmospheric temperatures.

General Foods Process (at Nampa, Idaho)

2. Onions are subsequently washed in a vegetable washing reel where additional peel is removed.
3. Tops and roots are trimmed by hand.
4. The onions are diced to a $\frac{3}{8}$ " x $\frac{3}{8}$ " size.
5. The chopped onions are inspected for defects and pumped in water to a dewatering shaker from which they fall into a tunnel freezer feed belt.
6. While on the tunnel freezer belt the chopped onions are subjected to a sub-zero degrees F. air blast and are frozen.
7. The frozen chopped onions are removed from the tunnel belt and are conveyed to bulk tote bins from which they are dumped as required to a filling machine wherein they are volumetrically packed in polyethylene bags (each containing 16 oz. of product).

(Step No. 1, including immersion of the onions in water at 140°-160° F. for a period of 6-4 minutes, is the direct antithesis of "substantially ambient atmospheric temperatures".)

An alternate peeling technique was previously employed at General Foods' Walla Walla plant. As set forth on page 2 of the Supplemental Answer to Interrogatory No. 2, raw onions were subjected to super-atmospheric temperatures at super-atmospheric pressures, determined to be about 250° F. at 20-25 lbs. per sq. in. gauge, for a period of 30 seconds. This procedure was abandoned in favor of hot water peeling.

As pointed out at page 2 of the above-mentioned Supplemental Answer, the heating of the onions is done for two reasons: The first is to facilitate removal of the skins in a vegetable peeler. The second is to eliminate coliform, which is a surface organism and is susceptible to elimination at the elevated temperatures set forth hereinabove.

In marked contrast, the patentees Groen and Rice represented to the Patent Office that:

"In fact applicants' principal discovery was that the blanching step is unnecessary in the quick freezing of raw onions." (Motion Exhibit B, page 12, last three lines.)³

This must be taken as a disclaimer of the desire for any heat, when read with the limitation of the claim that:

"* * * the entire process is carried out at substantially ambient atmospheric temperatures."

This disclaimer of any heating step is re-emphasized in Appellants' Brief pp. 4-5, wherein it is said:

³This was before the Patent Office Examiner cited Essipoff for the proposition that elimination of the blanching step was not inventive. (Motion Exhibit B, page 38) See also: the patentees' "Statement of Invention", Appeal Brief, Exhibit B, page 42.

“However, appellants’ position is that the uniqueness of their patent exists in (1) the process of individual (2) quick-freezing of (3) raw onion pieces (4) at substantially ambient temperatures, i.e., *without being subjected to any heat or blanching step.*” (Emphasis supplied)

Appellants, in desperation with respect to the showing of the existence of some fact issue, point (Brief p. 6) to Avon, New York, as another place where Appellee admits preparing onions and say that nothing in the record shows the process there employed, as distinguished from Nampa, Idaho, and Walla Walla, Washington. This is untrue. Appellee’s Answer (R. 60) to Interrogatory No. 2 was applicable to *all* of Appellee’s operations, wherever situated. The Supplemental Answer (R. 71) to Interrogatory No. 2 dealt specifically with the practices at Nampa, Idaho, and Walla Walla, Washington, insofar as they differed from the basic process employed by Appellee as set forth in the first answer to Interrogatory No. 2.

In all of the variations of Appellee’s process *the onions are subjected to heat* and this is the direct antithesis of Appellants’ patent claim and the interpretation Appellants put upon it.

In the General Foods process, the onions are subjected to a temperature of 160° F. This temperature is clearly above the temperature of the atmosphere in any normal place where onions are grown, transported or processed. More importantly, however, this temperature in the General Foods process causes actual physical changes in the skin of the onion. The skin of the onion actually becomes

softer as a result of the application of the 160° F. temperature.

For this reason, the General Foods process is different from the process claimed in the patent. Because of this difference, the General Foods process operates in a different way and produces a different result, i.e., softening of the skin of the onions by the application of heat, which the inventors expressly avoid. Since the General Foods process is different and produces a different result, it does not infringe.

CONCLUSION

It is respectfully submitted that the decision of the District Court in holding the single claim of the patent in suit invalid and in granting summary judgment with respect thereto was fitting and proper and should, therefore, be affirmed. Even assuming, *arguendo*, that the Patent Office applied the proper standards of invention in allowing the claim, which admits of grave doubt, the admitted state of the art (which the Patent Office never saw) showed the District Court a total want of invention or obviousness in an overwhelming degree. Under such circumstances and, according to *Rankin v. King*, *supra*, the granting of the Motion for Summary Judgment for invalidity was in order.

If, for any reason, this Court disagrees with the lower court's holding of invalidity, it may, if it so elects, proceed to a determination of the issue of infringement upon

the clear, convincing and non-controverted evidence before it showing non-infringement.

Dated, San Francisco, California,
January 2, 1968.

Respectfully submitted,
NAYLOR & NEAL,
By JAMES M. NAYLOR,
Attorneys for Appellee
General Foods Corporation.

CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

JAMES M. NAYLOR,
Attorney for Appellee.